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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,062

09/29/2005

Hirokatsu Nakano

K036-5637 (PCT)

6359

40627

7590

08/04/2006

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/551,062

Applicant(s)

NAKANO ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2005 and 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the Pre-amendments filed on 9/29/05 and 10/19/05. It is noted that in the pre-amendment of 9/29/05, applicant has amended the specification, and in the amendment of 10/19/05, applicant has made changes to the claims. In particular, applicant has canceled claims 1-6 and added new claims 7-12. The pending claims 7-12 are examined in this Office action.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

4. The drawings contained four sheets of figures 1-5 were received on 9/29/05. These drawings are approved by the Examiner.

***Specification***

5. The abstract of the disclosure is objected to because there is a grammatical error appeared in the abstract. In particular, on line 7, "an change" should be changed to --a change--. Correction is required. See MPEP § 608.01(b).
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
8. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shono (U.S. Patent No. 6,741,284) in view of Uchiyama et al (U.S. Patent No. 6,643,460).

Shono discloses a single lens reflex digital still camera. The camera as described in columns 2-3 and shown in figs. 1-2 comprises an imaging system and an observation system. The imaging system comprises an objective lens system (10), a quick-return mirror (11) and an imaging pickup device (12). The observation system comprises optics having a focusing plate (12), mirror (14), relay lens (15) and an eyepiece (16). The objective lens system comprises a

stationary lens group (10a) and a movable lens group (10b) which moves based on an output signal provided by a control circuit (29) connected to the image pickup device (12). The quick-return mirror (11) is a half mirror which is pivoted about a shaft (22) and disposed between the objective lens system and the image pickup device. The half mirror comprises a first surface for reflecting light passing through the objective lens system to the observation system and a rear surface for allowing light from the objective lens system to the image pickup device. The only feature missing from the reflex digital still camera provided by Shono is that he does not explicitly disclose that the rear surface of the quick-return mirror has an inclined surface with respect to its first surface for the purpose of correction an image-formation positional deviation when the quick-return mirror is inserted into the light path from the objective lens system to the image pickup device.

However, the use of a halfmirror in a reflex camera having a first surface for reflecting a light beam and a rear surface for allowing light passing to an image pickup device wherein the rear surface is a curved surface inclined with respect to the front surface for the purpose of correcting image position is known to one skilled in the art as can be seen in the camera provided by Uchiyama et al. in particular, Uchiyama et al disclose an optical system. The system as described in columns 2-6 and shown in figure 1 comprises the following features: First, an objective lens system (1); Second, a halfmirror (2) having a convex surface (2a) formed on its transmission surface; Third, an image pickup system (5-7)

disposed at a rear side of the halfmirror; and Fourth, an observation system (8-10) for observing an image reflected by the halfmirror (2). It is noted that the use of a convex element on the rear side surface which is inclined with respect to the front surface of the halfmirror is for the purpose of correcting a change in position of the image to be received by the image pickup system. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the reflex digital still camera as provided by Shono by using a halfmirror having a first surface for reflecting a light beam and a rear surface for allowing light passing to an image pickup device wherein the rear surface is a curved surface inclined with respect to the front surface as suggested by Uchiyama et al for the purpose of correcting image position when the halfmirror is inserted into the light path between an objective lens system and an image pickup device.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 7-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6 of U.S. Patent No. 6,822,802 in view of Uchiyama et al (U.S. Patent No. 6,643,460).

The telescope with the features as recited in present claims 7-12 of the present application is readable from the telescope claimed in Patent claims 1-3 and 6 except the feature related to the rear surface of the quick-return mirror in the form of a halfmirror for splitting light to an observation system and for transmitting light to the image element for correcting the image position.

However, the use of a halfmirror in a reflex camera having a first surface for reflecting a light beam and a rear surface for allowing light passing to an image

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pickup device wherein the rear surface is a curved surface inclined with respect to the front surface for the purpose of correcting image position is known to one skilled in the art as can be seen in the camera provided by Uchiyama et al. in particular, Uchiyama et al disclose an optical system. The system as described in columns 2-6 and shown in figure 1 comprises the following features: First, an objective lens system (1); Second, a halfmirror (2) having a convex surface (2a) formed on its transmission surface; Third, an image pickup system (5-7) disposed at a rear side of the halfmirror; and Fourth, an observation system (8-10) for observing an image reflected by the halfmirror (2). It is noted that the use of a convex element on the rear side surface which is inclined with respect to the front surface of the halfmirror is for the purpose of correcting a change in position of the image to be received by the image pickup system. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the telescope as claimed in claims 1-3 of Patent No. 6,822,802 by using a halfmirror having a first surface for reflecting a light beam and a rear surface for allowing light passing to an image pickup device wherein the rear surface is a curved surface inclined with respect to the front surface as suggested by Uchiyama et al for the purpose of correcting image position when the halfmirror is inserted into the light path between an objective lens system and an image pickup device.

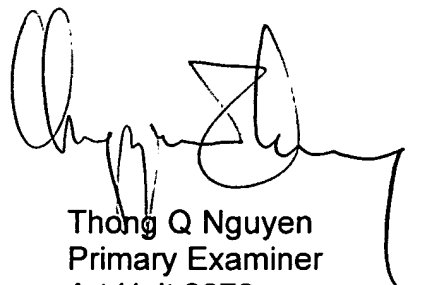


**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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